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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,007	02/27/2004	Janette Anyumba	FDN-2759	7988

7590 11/02/2005

Attn: William J. Davis, Esq.
INTERNATIONAL SPECIALTY PRODUCTS
Legal Department
1361 Alps Road, Building No. 10
Wayne, NJ 07470

EXAMINER

WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,007

Applicant(s)

ANYUMBA ET AL.

Examiner

Amanda C. Walke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Interpretation

1. The examiner notes the steps (d)-(f) of instant claim 17 are optional. Therefore, the limitations of instant claim 19 are met when the claimed step (d) is not present.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-29 are rejected under 35 USC 103(a) as being unpatentable over Lewis et al. (US 6,177,578 B1) in view of Lewis et al. (US 5,232,820 A). Lewis et al. (US '578) exemplifies a dispersion of a lithium salt of pentacos-10,12-diynoic acid (ex. 5). The dispersion was made by preparing a solution of (Part A) a lime-bone gelatin swelled and -dissolved in deionized water; (Part B) pentacos-10,12-diynoic acid dissolved in sodium hydroxide and deionized water and (Part C) lithium chloride dissolved in deionized water to form a 1M solution. Parts A, B and C were mixed to form a dispersion of lithium pentacos-10,12-diynoate. See also example 6. Example 7 exemplifies the said dispersion admixed with a surfactant and coated on a polyester film base. It is the examiner's position that pentacos-10,12-diynoic acid meets the limitations of instant claims 4-6 and 11. The taught lime-bone gelatin in deionized water meets the limitations of the matrix as set forth in instant claims 7-9. The said polyester film base meets the limitations of a substrate (instant cl. 13-14). The taught lithium chloride meets the limitation of the claimed lithium halide salt sensitizer (instant cl. 18). Lewis teaches that the taught

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compounds generally exist in an ordered state as in crystals or in an oriented monolayer (c. 1, l. 59-c.2, l. 6). Although Lewis is silent on the line to width ratio, it is the examiner's position that crystals of the taught lithium salt of pentacos-10,12-diynoate would inherently meet the limitations of a filamentary particle. Lewis teaches that the taught polyacetylenic components of the mixture have a distribution of particles sizes ranging from about submicron to about 10 μ m (c. 7, l. 45-48). It would have been obvious to one of ordinary skill in the art to modify the particles to any desired length to width ratio. Furthermore, the process to do so is well known and conventional in the art. This position is supported by the teachings of Lewis et al. (US 5,232,820 A) which discloses that crystals of undesirable size can be reformed by ageing or chilling with water reconstitution to provide a dispersion of more uniform crystal-line size within the desired range (c. 5, l. 1-4).

Response to Arguments

4. Applicant's arguments filed 8/22/2005 have been fully considered but they are not persuasive. Applicant has argued that the prior art of record fails to meet the instant claim limitations because the length to width ratio of the nanoparticles is not met by the reference. Firstly, applicant states that the ratio is not met because the particles/ crystals of the references are tabular, not filamentary (rod-like, needle-like, etc). The examiner has reconsidered the references, but does not find the references to teach that the particles are tabular, but instead, simply teach that the particles should have a certain size, which does not point to the crystals being tabular. Additionally, as stated previously by the examiner, given the size range, it would have been obvious to one of ordinary skill in the art to prepare the crystals of any size and the

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applicant must demonstrate how the length to width ratio affects the particles/ overall composition. From the MPEP (2144.04):

IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS

A. Changes in Size/Proportion

In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.).

In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

And MPEP (2144.05): Only Result-Effective Variables Can Be Optimized

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges

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of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result- effective variable.). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (prior art suggested proportional balancing to achieve desired results in the formation of an alloy). In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results.

As the examiner's position is reasonable and supported by the MPEP, the rejection of record is maintained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C. Walke whose telephone number is 571-272-1337.

The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Amanda C Walke
Examiner
Art Unit 1752

ACW
October 29, 2005